

## REMARKS

Claims 1, 3, and 9-14 were examined and reported in the Final Office Action. Claims 1, 3, and 9-11 stand rejected. Claims 12-14 stand allowed. Applicants amend claim 1 and assert that no new matter has been added therein. Accordingly, claims 1, 3, 9-14 are pending.

NY ( In the Advisory Action dated June 13, 2003, the Patent Office maintains the rejection of claims 1, 3, and 9 under 35 U.S.C. §102(b) as being anticipated by Li, (WO097/49136) (herein "Li"). Applicants submit that amended independent claim 1 is not anticipated by Li for at least the reason that Li does not teach, suggest or describe a metal oxide coating excluding Lithium (Li), as required by amended independent claim 1. For example, the Li reference teaches an alkali metal-metal oxide or an alkali metal-mixed metal oxide as described on page 6, line 8 through page 7, line 2. Specifically, in the examples of the Li reference, the coating metal oxide includes lithium metal.

On the other hand, independent claim 1, as amended, requires that the metal oxide not contain lithium. Hence, Applicants respectfully request that the Patent Office withdraw the rejection of amended independent claim 1 under 35 U.S.C. §102(b) as being anticipated by Li.

Applicants respectfully submit that dependent claims 3 and 9 are allowable for at least the same reason as allowable independent claim 1, from which they depend, and Applicants respectfully request the Patent Office withdraw the rejection to claims 3 and 9.

In addition, in the Advisory Action the Patent Office continues its rejection of claims 1, 3, and 9 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,372,385 issued to Kweon, et al. ("Kweon"). Applicants respectfully submit that the specification has been amended so that the above-captioned application is a Continuation-in-Part of co-pending U.S. Application Serial No. 09/248,202 which issued to Kweon as U.S. Patent No. 6,372,385 (i.e., Kweon cited by the Patent Office) (see MPEP §201.11 and 35 U.S.C. §120). Applicants respectfully submit that when filed, the above-captioned application was co-pending with Application No. 09/248,202. Applicants

respectfully submit that a proper reference to this application is being added by amended herein and that the above-captioned application now properly claims benefit to the earlier filing date by at least one common named inventor of the above-captioned application and Application No. 09/248,202.

Moreover, Applicants respectfully submit that the new time period requirements under 37 CFR §1.78(a)(2) and (a)5 are only applicable to utility or plant applications filed on or after November 29, 2000. Since the above-captioned application was filed June 16, 2000, the new time period requirements are not applicable. Accordingly, Applicants respectfully submit that Kweon is not prior art to the above-captioned application, and respectfully request that the Patent Office withdraw the rejection to claims 1, 3, and 9 as anticipated by Kweon.

In the Advisory Action the Patent Office continues the rejection of claims 10 and 11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,037,095 issued to Miyasaka ("Miyasaka") in view of Japanese Patent Abstract Publication No. 08-236114 issued to Nishida, et al. ("Nishida"). Applicants respectfully traverse the rejection.

As the Patent Office noted in the Final Office Action, "Miyasaka does not explicitly state the positive active material is coated with a metal oxide." In addition, Applicants respectfully submit that Miyasaka does not implicitly state the positive active material is coated with a metal oxide, or suggest the desirability of coating the positive active material with metal oxide.

Miyasaka teaches that the surface of the positive active electrode material can be modified, and gives examples of treating within an esterifying agent or chelating agent, coating with an electro-conductive polymer or polyethylene oxide, or coating with an iron-conductive polymer or a poly-acetylene layer, or treated with a lithium salt (Miyasaka, col. 10, lines 48-56). Applicants respectfully submit that Miyasaka does not teach or suggest the desirability of coating the positive active material with a metal oxide, in general, nor does Miyasaka teach or suggest the desirability of coating with the particular metal oxides as recited in Applicants' claims 10 and 11.

Applicants respectfully submit that Nishida does not remedy the defects of Miyasaka. Applicants respectfully submit that the Patent Office has failed to establish a *prima facie* case of obviousness since there is no suggestion or motivation to modify the reference or to combine the reference teachings. (MPEP §2142.) Applicants respectfully submit that the Patent Office is utilizing impermissible hindsight to remedy the defects of Miyasaka with the teachings of Nishida.

In the Advisory Action mailed June 13, 2003, the Patent Office stated that, "It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning." Applicants respectfully disagree.

The C.A.F.C. in the case of In re Ochiai held that, "When the references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned." (In re Ochiai, 71 F.3d 1565 at 1569, Fed.Cir. 1995.)

The Federal Circuit has disallowed the use of hindsight on numerous occasions, "in so erring, the Board impermissibly used hindsight to arrive at the claimed invention." (In re Zurko, 111 F.3d 887 at 889, Fed. Cir. 1997) "In determining obviousness, the invention must be continued as a whole without the benefit of hindsight, and the claims must be considered in their entirety." (Rockwell Intern. Corp. v. U.S., 147 F.3d 1358 at 1364, Fed. Cir. 1998) "Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome." (In re Kotzab, 217 F.3d 1365 at 1369, Fed. Cir. 2000) For at least the reasons stated above, Applicants respectfully request that the Patent Office withdraw the rejection to claims 10 and 11.

In the Final Office Action, the Patent Office rejected claims 10 and 11 under 35 U.S.C. §103(a) as being unpatentable over Miyasaka in view of Kweon. Applicants respectfully submit that Kweon is not prior art to the above-captioned application, as discussed above. Applicants respectfully request that the Patent Office withdraw the rejection to claims 10 and 11.

In the Final Office Action, the Patent Office allowed claims 12-14. Applicants would like to thank the Patent Office for allowing claims 12-14.

### CONCLUSION

In view of the foregoing, it is believed that all claims now pending (1) are in proper form, (2) are neither obvious nor anticipated by the relied upon art of record, and (3) are in condition for allowance. A Notice of Allowance is earnestly solicited at the earliest possible date. If the Patent Office believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly, extension of time fees.

### PETITION FOR EXTENSION OF TIME

Per 37 C.F.R. 1.136(a) and in connection with the Final Office Action mailed on THURSDAY, FEBRUARY 27, 2003, Applicants respectfully petition the Commissioner for a two (2) month extension of time, extending the period for response to MONDAY, JULY 28, 2003 (JULY 27, being a Sunday). The Commissioner is hereby authorized to charge payment to Deposit Account No. 02-2666 in the amount of \$410.00 to cover the petition filing fee for a 37 C.F.R. 1.17(a)(2) large entity. A duplicate copy of this sheet is enclosed.


Respectfully submitted,

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Dated: July 28, 2003

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By

  
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### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, Post Office Box 1450, Alexandria, Virginia 22313-1450 on July 28, 2003.

  
Margalux Rodriguez

July 28, 2003